or dermatological preparations need not contain an acyl lactylate is conveyed to persons skilled in the art by the instant examples, none of which contain an acyl lactylate. Consequently, persons skilled in the art would understand that Applicants invented cosmetic or dermatological preparations lacking a content of an acyl lactylate exactly as claimed in new claims 41-43. Consequently, claims 41-43 do not introduce new matter. *See, also, e.g., In re Anderson,* 176 USPQ 331, 336 (CCPA 1973), for the proposition that in determining whether an amendment to a claim constitutes new matter, the question is not whether the added words are words that are used in the application as filed, but whether the concept embodied by the added words is present in the original specification. Since the specification clearly conveys the concept of cosmetic or dermatological preparations lacking a content of an acyl lactylate, claiming such preparations in those terms does not introduce new matter.

The sole issue for consideration is the rejection of claims 11-40 under 35 USC §103(a) as being obvious over Dahms et al. ("Dahms"), U.S. Patent No. 5,744,062, in view of Aronson et al. ("Aronson"), U.S. Patent No. 4,606,913, and Kurtz et al. ("Kurtz"), *SOFW J., 123(3)* 1997. In response, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

Claims 41-43

A critical feature of the Dahms reference, and, thus, of the cited combination of references is the use of an acyl lactylate as the primary emulsifier. Indeed, Dahms expressly

teaches at column 5, lines 29-31, that ***"it is <u>the</u> selection of a proper <u>acyl lactylate</u>,*** and in proper amount, that provides a balanced emulsifier blend," which is the entire object of Dahms's invention. Accordingly, no combination of Dahms, Aronson and Kurtz could possibly teach or suggest the preparation and use of cosmetic or dermatological preparations ***lacking*** an acyl lactylate. Since instant claims 41-43 lack an acyl lactylate, these claims are not *prima facie* obvious over the combination of Dahms, Aronson and Kurtz.

<u>Claims 11-21</u>

Applicants do not claim to have invented partially neutralized esters of monoglycerides and/or diglycerides of saturated fatty acids with citric acid; or sorbitan monoesters; or fatty alcohols. What Applicants claim to have invented is that combinations of these three ingredients have the effect of stabilizing emulsions having a content of electrolytes. The question is whether there is anything in the cited combination of references that either teaches or suggests that these ingredients should be combined or that their combination would have the beneficial properties that Applicants have disclosed. Applicants submit that there is no such teaching or suggestion in the cited combination of references. Consequently, claims 11-21 are not rendered *prima facie* obvious by the cited combination of Dahms, Aronson and Kurtz.

The Examiner purports to have found examples of each of these three ingredients in the laundry list of coemulsifiers in Dahms at column 5, line 33, continuing over to column 6, line 27. However, Applicants respectfully request clarification where cetearyl alcohol fits into instant

ingredients (I), (II) or (III). Applicants submit that even if the Examiner's position is correct, the presence of examples of these three ingredients in such a laundry list is insufficient to make out a *prima facie* case of obviousness since there is absolutely no teaching or suggestion in Dahms alone or in combination with Aronson and Kurtz that these three ingredients should be combined. Absent such teaching or suggestion, Applicants submit that a *prima facie* case of obviousness cannot have been made out.

Dahms does recite at the very end of the laundry list the words "and mixtures thereof," which at least on some level suggests the ingredients in the laundry list can be used in combination. However, the laundry list is long, and with the possibility of using mixtures, there are millions of possible combinations, and there is absolutely nothing else in Dahms to direct a person skilled in the art to a specific combination of partially neutralized esters of monoglycerides and/or diglycerides of saturated fatty acids with citric acid; and sorbitan monoesters; and fatty alcohols. Accordingly, the instantly claimed combination of these three ingredients would not, in fact, have been *prima facie* obvious.

Further on this point, Applicants would call the attention of the Examiner to the decision in *In re Baird,* 29 USPQ2d 1550 (Fed. Cir. 1994). In that case, the Court expressly held that "[t]he fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious." *See, Baird,* 29 USPQ2d at 1552. While it is true, and this was accepted by the Court in *Baird,* that a reference must be considered not only for what it expressly teaches, but also for what it fairly suggests, the Examiner has not explained

why, given the breadth of the reference teachings, and the lack therein of any subgeneric language or examples leading towards the inventive preparations, a person of ordinary skill in the art would have been motivated to make and use the instant preparations as claimed. Applicants respectfully submit that such a person would not have been so motivated, and, therefore, no *prima facie* case of obviousness has been made out.

As the Court in Baird stated, "A disclosure of millions of compounds does not render obvious a claim to three compounds, particularly when that disclosure indicates a preference leading away from the claimed compounds." In the instant case, there are millions of possible combinations from amount Dahms laundry list, whereas Applicants claim a specific combination. Dahms does not highlight Applicants' ingredients in Applicants' specific combination in any way that would make their selection more likely. Moreover, the Examiner has not pointed to anything in Dahms, Aronson or Kurtz or in their combination that would have led persons skilled in the art to make the selections that would be necessary to achieve the claimed preparations. Accordingly, the present record is lacking sufficient evidence that a person having ordinary skill in the art would, in fact, have been motivated to make and use the instantly claimed preparations.

Claim 22

Since the preparations of claims 11-21 are novel and unobvious, the method of claim 22 of using the novel and unobvious preparations of claims 11-21 must also be novel and unobvious

as a matter of law. *See, for example, In re Ochiai,* 37 USPQ2d 1127 (Fed. Cir. 1995); and *In re Brouwer,* 37 USPQ2d 1663 (Fed. Cir. 1996).

Claims 23-40

The Examiner has made out a case, based primarily on Aronson, that it would have been obvious to add a sufficient amount of an ***electrolyte*** to stabilize an emulsion. However, this is ***not*** what is required by claims 23-40. Instead, claims 23-40 require incorporating ***ingredients (I)-(III)*** to stabilize the ***instability brought on by the presence of the electrolytes.*** In short, there is no teaching or suggestion of the method of claims 23-40 in the combination of Dahms, Aronson and Kurtz.

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw this rejection altogether. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to

telephone the undersigned at telephone number (914) 332-1700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.116 and the accompanying Request for Continued Prosecution and Petition for Extension of Time (10 pages total) are being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: January 2, 2003

By
Kurt G. Briscoe